



# UNITED STATES PATENT AND TRADEMARK OFFICE

*mn*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,075	11/03/2003	Mark M. Josephsen	100202485-1	3736

22879 7590 07/16/2007  
HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
----------

LANIER, BENJAMIN E

ART UNIT	PAPER NUMBER
----------	--------------

2132

MAIL DATE	DELIVERY MODE
-----------	---------------

07/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/700,075	Applicant(s) JOSEPHSEN ET AL.	
	Examiner Benjamin E. Lanier	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment filed 19 March 2007 amends claims 1-10, 12-14, 16, 18, and 21. Claims 19 and 20 have been cancelled. Applicant's amendment has been fully considered and entered.

2. The declaration filed on 19 March 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Partelow reference.

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Partelow reference to either a constructive reduction to practice or an actual reduction to practice. Exhibit A appears to show conception of the claimed invention however, no explanations were provided in the declaration to explain the gaps in activity.

#### MPEP 715.07(a)

In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the **record must set forth an explanation or excuse for the inactivity**; the USPTO or courts will not speculate on possible explanations for delay or inactivity. See *In re Nelson*, 420 F.2d 1079, 164 USPQ 458 (CCPA 1970).

#### MPEP 2138.06

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not

enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter “was diligently reduced to practice” is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

**The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses.** Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent’s entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ

318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) (“[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus”); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).

4. The Declaration of inventors Josephsen, Reese, and Konsella, fails to account for the periods of inactivity where diligence is required by either affirmative acts or acceptable excuses. The Declaration shows that an email was sent from the HP Legal Department to the inventors on 13 March 2002, however, the next action reported by the Application is not until 15 January 2003. As cited above, an Applicant must account for the entire period during which diligence is required. Here, Applicant has a gap of over 10 months over a critical period spanning the date of

Art Unit: 2132

the reference (10 July 2002). Therefore, (a) there is no showing of diligence from prior to the reference data and (b) diligence is not proved for the entire period.

5. There is a period of inactivity between 15 January 2003 and 14 February 2003 from when the Intellectual Property Section of the HP Legal Department notified the inventors that patent protection will be pursued for their invention until an agreement for patent attorney Richard E. Billion was signed. The Office will not speculate as to the conditions of the attorney's docket and practice. Therefore, the Examiner has not been presented with adequate information to arrive at the conclusion that the attorney was reasonably diligent.

6. There is a period of inactivity between 14 February 2003 and 19 February 2003 from when the agreement was signed by Mr. Billion until the same agreement was signed by HP Attorney James R. McDaniel. Once again, the Office will not speculate as to the conditions of the attorney's docket and practice. Therefore, the Examiner has not been presented with adequate information to arrive at the conclusion that the attorney was reasonably diligent.

7. There is a period of inactivity between 19 February 2003 and 18 June 2003 from when the agreement was signed by Mr. McDaniel until a draft of the application was received by the inventors. Again, the Office will not speculate as to the conditions of the attorney's docket and practice. Therefore, the Examiner has not been presented with adequate information to arrive at the conclusion that the attorney was reasonably diligent.

8. There is a period of inactivity between 20 June 2003 and 20 August 2003 from when an email communication between co-inventors occurred until HP Legal Administrative Assistant Betty Hinkle provided an email indicating that the application had been reviewed and approved

for filing. No affirmative acts or acceptable excuses has been identified for this period of inactivity.

9. There is a period of inactivity between 20 August 2003 and 07 October 2003 from when the indication of application approval was emailed until the inventors were requested to Declaration and Assignment papers in order to being the filing process. No affirmative acts or acceptable excuses has been identified for this period of inactivity. Again, the Office will not speculate as to the conditions of the attorney's docket and practice. Therefore, the Examiner has not been presented with adequate information to arrive at the conclusion that the attorney was reasonably diligent.

10. Lastly, there is a period of inactivity between 07 October 2003 and 03 November 2003 from when the inventors were requested to sign application documents until the patent application was actually filed. Again, the Office will not speculate as to the conditions of the attorney's docket and practice. Therefore, the Examiner has not been presented with adequate information to arrive at the conclusion that the attorney was reasonably diligent.

#### ***Response to Arguments***

11. Applicant's argument that the claim amendments have overcome the §101 rejections of claims 1-9 and 19 has been fully considered and is persuasive. The §101 rejections of claims 1-9, and 19 have been withdrawn.

12. Applicant's arguments that the claim amendments have overcome the objections to claims 4, 9, 13, 18, and 21 have been fully considered and are persuasive. The objections to claims 4, 9, 13, 18, and 21 have been withdrawn.

Art Unit: 2132

13. Applicant's argument that the claim amendments have overcome the §112, second paragraph rejection of claim 1 has been fully considered and is persuasive. The the §112, second paragraph rejection of claim 1 has been withdrawn.

14. Applicant's arguments that "Accompanying this Amendment and Response is a Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application in the United States prior to the earliest effective date of July 10, 2002 of the Partelow Publication coupled with due diligence from a date prior to the earliest effective date of the Publication up to the filing date of the present patent application (i.e. constructive reduction to practice)," and "Applicant submits that the Partelow et al. U.S. Patent Application Publication No. 2004/0008842 does not qualify as a reference under 35 U.S.C. 102(e) and, therefore, does not qualify as a reference under 35 U.S.C. 103(a)," are not persuasive because, as discussed above, the Declaration fails to show due diligence from a date prior to the earliest effective date of the Partelow Publication up to the filing date of the present patent application. Therefore, the Partelow reference still qualifies as a reference under 35 U.S.C. 102(e) and 35 U.S.C. 103(a).

***Claim Rejections - 35 USC § 102***

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.



Art Unit: 2132

16. Claims 1, 2, 4, 5, 9-11, 13, 14, 18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Partelow et al., U.S. Patent Publication No. 2004/0008842 A1, (herein after "Partelow").

17. Regarding claim 1: Partelow discloses a printer (Figure 2, element 16 & [0017]) comprising: a security module ([0017] lines 1-3) within the printer that is operable to:

receive a message from an attached computer requesting secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key ([0018] line 7).

18. Regarding claim 10: Partelow discloses a machine-readable medium ([0015] lines 11-12) with instructions stored thereon, the instructions when executed operable to cause a printer ([0017] line 1) to:

receive a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generate a key in response to the received message ([0018] lines 6-7); and

send the key to the attached computer requesting the key ([0018] line 7).

19. Regarding claims 2 and 11: Partelow discloses a generated key comprising a symmetric encryption key ([0021] lines 1-7).

20. Regarding claims 4 and 13: Partelow discloses a symmetric key is a DES key ([0021] line 7).

21. Regarding claims 5 and 14: Partelow discloses that generating the key comprises generating a public key and a private key ([0021] line 8), and sending the key to the attached

Art Unit: 2132

computer requesting the key comprises sending the public key to the attached computer requesting the key ([0025] line 3).

22. Regarding claims 9 and 18: Partelow discloses that the attachment between the printer and the attached computer is a network attachment ([0013] line 3).

23. Regarding claim 21: Partelow discloses a method of managing a printer in a computerized system external to the printer ([0019] lines 1-3), comprising:

receiving a message from an attached computer requesting a secure printing key ([0018] lines 1-4);

generating a key in response to the received message ([0018] lines 6-7); and

sending the key to the attached computer requesting the key ([0018] line 7).

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 2132

26. Claims 3, 6, 12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partelow, in view of Berstis et al., U.S. Patent No. 6,282,653 B1, (hereinafter "Berstis").

27. Regarding claims 3, 6, 12, and 15: Partelow does not disclose sending the key to the attached computer over a secured connection.

Berstis disclose sending the key to the attached computer over a secured connection (col. 7, line 5).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Partelow by the secured connection as taught by Berstis in order to protect the content (key) from unauthorized access.

28. Claims 7, 8, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partelow, in view of Lee, U.S. Patent No. 6,628,413 B1, (hereinafter "Lee").

29. Regarding claims 7 and 16: Partelow does not disclose receiving the message from an attached computer via a web server hosted within the printer.

Lee discloses receiving the message from an attached computer via a web server hosted within the printer (col. 3, lines 52-54).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Partelow by web server taught by Lee for the benefit of Internet accessible printing.

30. Regarding claims 8 and 17: Partelow does not disclose a Java virtual machine within the printer.

Lee discloses a Java virtual machine within the printer (col. 3, lines 64-65).

Therefore it would have been obvious to one skilled in the art at the time of the invention to modify Partelow by the Java Virtual Machine taught by Lee in order to have portability when new processors become available.

***Conclusion***

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

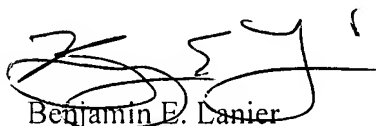
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Benjamin E. Lanier